



Patent
Attorney's Docket No. 028870-224

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re Patent Application of |) | |
| David C. Greenspan, et al. |) | Group Art Unit: 1614 |
| Application No.: 09/560,046 |) | Examiner: John Pak |
| Filed: April 27, 2000 |) | |
| For: Anti-Inflammatory and Antimicrobial Uses |) | |
| for Bioactive Glass Compositions |) | |

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

Assistant Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

In response to the Restriction and Election of Species Requirement mailed December 18, 2001, Applicants respectfully traverse the restriction and election of species requirement as set forth in the Office Action.

In the Office Action, the Examiner sets forth a restriction requirement among four groups of the claims:

- I. Claims 1 - 12, 15 - 22, 24 - 37 and 48 - 49, drawn to composition, device, and method wherein wound, burn, scar tissue, inflammation or bacterial infection are treated with bioactive glass.
- II. Claims 13 - 14, drawn to a method for grafting skin comprising applying bioactive glass to a graft site and/or donor tissue.
- III. Claims 38 - 40, drawn to an aqueous extract of small particles of bioactive glass.
- IV. Claims 41 - 47, drawn to cosmetic products containing particles of bioactive glass or aqueous extracts thereof.

Moreover, the Examiner further requires election of a single disclosed species of bioactive glass with all of its components specified.

In response, Applicants respectfully assert that all groups and embodiments of claims 1 - 49 should properly be examined together. Applicants note that the various groups and embodiments of the invention are so closely related that a proper search of any would, by necessity, require a proper search of the others. Thus, Applicants submit that all of the groups and embodiments can be

searched simultaneously, and that a duplicative search, with possibly inconsistent results, may occur if the restriction and election of species requirement is maintained.

Applicants submit that any nominal burden placed upon the Examiner to search accordingly to determine the art relevant to Applicants' overall invention is significantly outweighed by the public's interest in not having to obtain and study many separate patents in order to have available all of the issued patent claims covering Applicants' invention. The alternative is to proceed with the filing of multiple applications, each consisting of generally the same disclosure, and each being subjected to essentially the same search, perhaps by different Examiners on different occasions. This process would place an unnecessary burden on both the Patent and Trademark Office and on the Applicants.

Regardless of whether the groups and embodiments are independent or distinct, Applicants respectfully assert that the making of a restriction and election of species is not mandatory in all instances where it is possible to do so. Rather, the Examiner may use discretion and choose not to make a restriction and election of species where circumstances warrant. It is believed that such is the case in the present application.

Accordingly, in the interest of economy, for the Office, for the public-at-large, and for Applicants, reconsideration and withdrawal of the election requirement are requested.

Nevertheless, in order to comply with the requirements of 37 C.F.R. § 1.143 and MPEP § 809.02(a), Applicants provisionally elect, with traverse, to prosecute the claims of Group I, namely claims 1 - 12, 15 - 22, 24 - 37 and 48 - 49 and the species in which the bioactive glass has a composition by weight percentage as follows:

| <u>Component</u> | <u>Percent</u> |
|-------------------------------|----------------|
| SiO ₂ | 40-86 |
| CaO | 10-46 |
| Na ₂ O | 0-35 |
| P ₂ O ₅ | 2-8 |
| CaF ₂ | 0-25 |
| B ₂ O ₃ | 0-10 |
| K ₂ O | 0-8 |
| MgO | 0-5 |

Applicants submit that claims 7, 27, 33, and 43 read on the elected species, and that claims 1-6, 9-12, 15-22, 29-32, 35-37, and 48-49 are generic claims.

Applicants earnestly solicit favorable consideration of the above response and early passage to issue the present application. The Examiner is invited to contact the undersigned at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Applicants reserve the right to file a divisional application covering the non-elected subject matter.

Respectfully submitted,

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